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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/095,842	06/11/1998	TAKAYUKI ARAKI	VX961463A-PC	1105
21369	7590	10/12/2005	EXAMINER	
POSZ LAW GROUP, PLC 12040 SOUTH LAKES DR. SUITE 101 RESTON, VA 20191			SZEKELY, PETER A	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/095,842	ARAKI ET AL.
	Examiner	Art Unit
	Peter Szekely	1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 January 2005.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 12-23 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 12-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. 08/612,865.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 12-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The subject matter of claims 12-17 is outside the limits of applicants' invention. Applicants' specification on page 1, lines 10-1 states: "More specifically the present invention relates to an aqueous dispersion of a vinylidene fluoride (VdF) type polymer, which comprises a VdF polymer having a particle size if not more than 200 nm". Additionally, in the paragraph overlapping pages 3 and 4 said specification further states "The present invention has been made to solve the above mentioned problems and it is an object of the present invention to provide an aqueous dispersion of a fluorine-containing polymer, which comprises a VdF polymer having a particle size as small as not more than 200 nm and contains solids in an amount as high as 30 to 50 % by weight and a surfactant in an amount as low as not more than 1 % by weight on the basis of water, and its preparation process." Since claims 12-14 claim a particle size up to 320.1 nm and claims 15-17 claim up to 2% by weight of surfactant, said claims are broader than the specification and cannot possibly be enabled by it. Furthermore, there

is no mention in the specification of "an average particle size no more than 320.1 nm" or "a content of a fluorine-containing surfactant is not more than 2% by weight on the basis of water". "Particle size (nm) 320.1" and "Surfactant (%by weight) PFOA (2.0)" are single points in Table I representing data in Comparative Examples. The subject matter described in the Comparative Examples is not part of the invention and as such it cannot be enabled. Furthermore, as it was explained in the previous Office action, claims 12-14 totally encompass the material claimed in canceled claims 6-11 and claims 15-17 overlap 98% of the material claimed in canceled claims 6-11, which claims were held to be unpatentable by the majority decision of the Board or Appeals and Interferences. If part of a range is not enabled, it means that the whole range, which necessarily includes the non-enabled part, is also not enabled. The fact that the Board of Appeals and Interferences reversed the examiners "written description" i.e. new matter rejection does not mean that the claims in question are automatically enabled. New matter and enablement are completely different matters as the enclosed denial of applicants' petition shows it. While the examiner ought to have rejected claims 12-17 for non-enablement in the Examiner's Answer, but did not, this has now been rectified with the present action and the previous Office action. The rejection is maintained.

3. Claims 18-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 18-23 differ from canceled claims 6-11 only in one aspect, namely

"comprising" has been changed to "consisting essentially of". Since the phrase "consisting essentially of" only excludes ingredients which would materially affect the basic and novel characteristics of the product in the balance of the claim (see *In re Garnero* 162 USPQ 221-224 [CCPA 1969]) or ingredients which would deleteriously affect obtaining the properties or use which applicants seek in the sole use of the commonly required additive(s) (see *In re Herz* 190 USPQ 461 [CCPA 1976]; *In re Janakirama-Rao*, 137 USPQ 893 [CCPA 1963]), it is not clear why applicants believe that this limitation would provide enablement for the claims. The lack of enablement is not due to an extra, unwanted ingredient, but for the lack of an essential additional ingredient, namely the non-ionic, non-fluorine containing surfactant which is critical or essential to the practice of the invention claimed in claims 18-23, but not included in the claims, which therefore are not enabled by the disclosure (see *In re Mayhew*, 188 USPQ 356 [CCPA 1976]). See page 3, lines 4-12, page 4, lines 13-21 and page 6, lines 25-37 of the instant specification. There is no showing in the specification that the desired particle size can be achieved when no more than 1% by weight of fluorine-containing surfactant is used, unless there is also present a non-fluorine-containing surfactant in amounts of 0.001-0.1% by weight. The rejection is maintained.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (571) 272-1124. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Peter Szekely  
Primary Examiner  
Art Unit 1714

P.S.  
9/30/05